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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/771,503 01/26/01 YUE

H PC-0027 US

HM12/1031

EXAMINER

LEGAL DEPARTMENT  
INCYTE GENOMICS, INC.  
3160 PORTER DRIVE  
PALO ALTO CA 94304

CANELLA, K

ART UNIT	PAPER NUMBER
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1642

DATE MAILED:

10/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No. 09/771,503	Applicant Yue et al
Examiner Karen Canella	Art Unit 1642

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 days MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on \_\_\_\_\_
- 2a)  This action is FINAL. 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 835 C.D. 11; 453 O.G. 213.
- 4)  Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) \_\_\_\_\_ is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims 1-21 are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15)  Notice of References Cited (PTO-892) 18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 19)  Notice of Informal Patent Application (PTO-152)
- 17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20)  Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, drawn to isolated cDNA of SEQ ID NO:2, fragments, compositions, vectors and host cells thereof, classified in class 536, subclass 23.5, and class 435, subclasses 69.1 and 320.1.
  - II. Claims 8-13 drawn to a method of using cDNA to detect expression of a nucleic acid and a method of using cDNA to detect a plurality of molecules, classified in class 435, subclass 6. Claims 12 and 13 will be examined with this group to the extent that they read on the detection of polynucleotide-polynucleotide hybridization complex
  - III. Claims 12-13 and 16 and 17, drawn to a method of using cDNA to detect a plurality of molecules, and a method of using a protein to screen for a plurality of molecules, classified in class 436, subclass 501. Claims 12 and 13 will be examined with this group to the extent that they read on the detection of a polynucleotide-protein or polynucleotide-peptide complex. Claims 16 and 17 will be examined with this group to the extent that they read on the detection of a protein-polynucleotide complex.
  - IV. Claims 16-18, drawn to a method of using a protein to isolate antibodies and a method of using a protein to screen for a plurality of molecules, classified in class 435, subclass 4. Claims 16 and 17 will be examined with this group to the extent that they read on the detection of a complex which does not comprise a polynucleotide or an antibody.
  - V. Claim 19, drawn to an antibody, classified in class 530, subclass 387.1.
  - VI. Claims 16, 17, 20 and 21, drawn to a method for using an antibody to diagnose conditions or diseases and a method of using a protein to screen for a plurality of molecules, classified in class 435, subclass 7.1. Claims 16 and 17 will be

examined with this group to the extent that they read on the detection of a protein-antibody complex.

VII. Claims 14 and 15, drawn to purified proteins and compositions comprising SEQ ID NO:1, classified in class 514, subclass 21.

2. The inventions are distinct, each from the other because of the following reasons:

The Inventions of Groups I, V and VII are structurally and functionally different products which are made by different methods and have different uses. The examination of all groups would require different searches in the U.S. Patent Shoes and the scientific literature and would require the consideration of different patentability issues.

The methods of Groups II, III, IV and V differ in the method objectives, method steps and parameters and in the reagents used.

Inventions I is related to Inventions II and III as product and processes of use. Invention VII is related to Invention III, IV and VI as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case as the products of Groups I and VII are used in the instant application in multiple and distinct processes of detection.

Inventions V and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody of Invention V can be used in a process of raising an anti-idiotypic antibody.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent

subject matter and because the searches required for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Geetha P. Bansal*  
Geetha P. Bansal  
PRIMARY EXAMINER  
P.T.O.

Karen A. Canella, Ph.D.  
Patent Examiner, Group 1642  
October 22, 2001